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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,935	02/06/2004	Michael L. Jackson	A01495	7968

21898 7590 04/25/2006
ROHM AND HAAS COMPANY
PATENT DEPARTMENT
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EXAMINER

MULLIS, JEFFREY C

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/773,935	Applicant(s) JACKSON ET AL.	
	Examiner Jeffrey C. Mullis	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>May 20 2005</u> | 6) <input type="checkbox"/> Other: _____ |

Applicant's election with traverse of anhydride modified MPP and acrylic resin in the reply filed on 5-20-05 is acknowledged. The traversal is on the ground(s) that undue burden of search does not exist. This is not found persuasive because the search for the various species is not coextensive and the reasonable number of species referred to by MPEP 1.141 pertains to situations where an allowable generic claim is present.

The requirement is still deemed proper and is therefore made FINAL.

No terminal disclaimer has been received as applicants allege was filed.

Claims 1-4 and 6-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed does not disclose that the MPP having one or two terminal groups in addition is modified by groups. The limitation that the "MPP contains one or two terminal carboxyl, anhydride, hydroxyl or epoxy groups" implies that terminal groups are part of the MPP itself while the limitation that the "said MPP or MPP copolymer is modified with one or more than one carboxyl, anhydride, hydroxyl or epoxy group" implies that possibly the already terminally modified MPP is further modified. However the specification as filed does not disclose that the (terminally modified) MPP is further modified and these limitations are therefore new matter. The limitation that the MPP's have terminal olefin double bonds as well as

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“terminal carboxyl, anhydride, hydroxyl or epoxy groups” was not present in the specification as filed and is therefore new matter.

Claims 1-4 and 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear if the “MPP or MPP copolymer (which) is modified with one or more than one carboxyl, anhydride, hydroxyl or epoxy group” refers to further modification of the already terminally modified MPP's or pertains to the terminal groups which are already present as the claims can be interpreted both ways. The presence of “terminal olefin double bond(s)” in claim 4 is contradictory to “terminal carboxyl, anhydride, hydroxyl or epoxy groups” as recited in claim 1 and claim 4 therefore lacks antecedent basis in claim 1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Rieger et al. (DE 4227217).

Patentees disclose a composition containing an "isotactic polypropylene" with a terminal hydroxyl group derived from an isotactic polypropylene with a terminal olefinic group having a molecular weight of 1100. The composition also contains grafted EP copolymer. Note the abstract.

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanna (US 2004/0059046).

Patentees disclose an isotactic PP of number average molecular weight of 1100 terminally modified by hydroxyl groups present with UNITHOX 750 ethoxylate (as in applicants polymer or resin). Note Example 23 in this re. Note use of chlorinated PVC in paragraph 74. It is noted that the above publishes application is assigned to Baker Hughes and the page 6, line 25 of the instant specification indicates that Baker Hughes Makes MPP's suitable for applicants invention.

Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujita et al (US 5,130,371).

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Fujita discloses a composition containing a homopolypropylene graft polymer and polycarbonate. Note for instance Example 13. Note that the only conditions disclosed for producing homopolypropylene are that for producing isotactic polypropylene with Zeigler Natta catalyst at column 5, lines 28-33. Note column 6, lines 61-66 where it is disclosed that grafting of polypropylene with maleic anhydride under free radical polymerization conditions results in anhydride groups introduced almost solely at the point of chain scission, ie at the terminal of the newly formed maleienated polypropylene. Note the examples for polypropylene containing 4% maleic anhydride for which a number average molecular weight of about 2,000 can be calculated based on one maleic anhydride present only at the chain ends.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis
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Art Unit 1711

JCM

4-19-06

Jeffrey Mullis
Primary Examiner
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